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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,948	07/11/2006	Yasunori Gamo	293128US3PCT	1473

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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MCCLELLAND, KIMBERLY KEIL

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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08/14/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/585,948	<b>Applicant(s)</b> GAMO ET AL.	
	<b>Examiner</b> KIMBERLY K. MCCLELLAND	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/06, 12/12/07</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Double Patenting***

1. Applicant is advised that should claim 7 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "the face plate" in line 9. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 3 is an incomplete sentence. Clarification is required.

6. Claim 7 recites the limitation "the face plate" in line 5. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 8 recites the limitation "the face plate" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,395,120 to Bradbury-Harris et al.

10. With respect to claim 1, Bradbury-Harris discloses a transfer apparatus, including a film withdrawing mechanism (i.e. take-off roller 28); a film carrying mechanism (see guide roller 26); a transfer mechanism (27); and a film winding mechanism (i.e. take-up roller 28; See Figure 1).

11. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. &

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Inter. 1987). See MPEP § 2114. The phrases, “which withdraws, starting at one end, a transfer film from a wound body of the transfer film formed by applying at least a metal film onto a base film”, “which carries the transfer film withdrawn, starting at one end, by the film withdrawing mechanism to the downstream side”, “which transfers the metal film via an adhesive layer by heating while pressing the transfer film carried by the film carrying mechanism against a phosphor surface disposed on the face plate”, and “which winds while peeling the base film from the transfer film from which the metal film is transferred by the transfer mechanism” are found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus.

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

12. As to claim 2, Bradbury-Harris discloses an adhesive agent coating mechanism (22) and an adhesive agent drying mechanism (23; See Figure 1).

13. The phrases, “which coats an adhesive agent onto the metal film of the transfer film”, and “which dries the adhesive agent coated by the adhesive agent coating mechanism installed at a previous stage of the transfer mechanism” are found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus

14. As to claim 3, Bradbury-Harris discloses a wrinkle-removing mechanism (i.e. roller immediately upstream of transfer roller 27; See Figure 1).

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15. The phrase, "which removes wrinkles which might be produced on the transfer film on the downstream side in the vicinity of the film withdrawing mechanism and in the vicinity of the disposed position of the transfer mechanism" is found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus

16. As to claim 5, examiner notes this claim is drawn to the intended operation of the current apparatus. Bradbury-Harris discloses an apparatus which runs at a carrying speed and coating time (column 8, lines 29-41; See Figure 3), and is therefore capable carrying the transfer film by the film carrying mechanism in a range of 0.1 m/min to 10 m/min, and an adhesive agent coating time can be set in a unit of one second.

17. As to claim 6, examiner notes this claim is drawn to the intended operation of the current apparatus. Bradbury-Harris discloses the transfer mechanism which provides heat and pressure (column 8, lines 29-41; See Figure 3) and is therefore capable of having a pressing force against the transfer film in a range of 300 to 1500 kg/cm<sup>2</sup> and a heating temperature in a range of 150 to 240°C.

18. Claims 1, 3, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,5000,291 to Okada et al.

19. With respect to claim 1, Okada discloses a transfer apparatus, including a film withdrawing mechanism (2); a film carrying mechanism (4); a transfer mechanism (9); and a film winding mechanism (14; See Figure 1).

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20. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114. The phrases, “which withdraws, starting at one end, a transfer film from a wound body of the transfer film formed by applying at least a metal film onto a base film”, “which carries the transfer film withdrawn, starting at one end, by the film withdrawing mechanism to the downstream side”, “which transfers the metal film via an adhesive layer by heating while pressing the transfer film carried by the film carrying mechanism against a phosphor surface disposed on the face plate”, and “which winds while peeling the base film from the transfer film from which the metal film is transferred by the transfer mechanism” are found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

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21. As to claim 3, Okada discloses a wrinkle-removing mechanism (11/12; See Figure 1).

22. The phrase, "which removes wrinkles which might be produced on the transfer film on the downstream side in the vicinity of the film withdrawing mechanism and in the vicinity of the disposed position of the transfer mechanism" is found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus

23. As to claim 6, examiner notes this claim is drawn to the intended operation of the current apparatus. Okada discloses the transfer mechanism which provides heat and pressure (column 7, lines 57-65) and is therefore capable of having a pressing force against the transfer film in a range of 300 to 1500 kg/cm<sup>2</sup> and a heating temperature in a range of 150 to 240°C.

24. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0158960 to Kasperchik et al.

25. With respect to claim 1, Kasperchik discloses a transfer apparatus, including a film withdrawing mechanism (16); a film carrying mechanism (i.e. guide rollers); a transfer mechanism (14); and a film winding mechanism (18; See Figure 1).

26. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997);



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“[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114. The phrases, “which withdraws, starting at one end, a transfer film from a wound body of the transfer film formed by applying at least a metal film onto a base film”, “which carries the transfer film withdrawn, starting at one end, by the film withdrawing mechanism to the downstream side”, “which transfers the metal film via an adhesive layer by heating while pressing the transfer film carried by the film carrying mechanism against a phosphor surface disposed on the face plate”, and “which winds while peeling the base film from the transfer film from which the metal film is transferred by the transfer mechanism” are found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus.

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

27. As to claim 6, examiner notes this claim is drawn to the intended operation of the current apparatus. Kasperchik discloses the transfer mechanism which provides heat and pressure (see paragraph 0024) and is therefore capable of having a pressing force

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against the transfer film in a range of 300 to 1500 kg/cm<sup>2</sup> and a heating temperature in a range of 150 to 240°C.

28. Claims 1, 3, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,004,420 to Nakamura et al.

29. With respect to claim 1, Nakamura discloses a transfer apparatus, including a film withdrawing mechanism (2a); a film carrying mechanism (15); a transfer mechanism (10); and a film winding mechanism (2b; see Figure 1).

30. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114. The phrases, “which withdraws, starting at one end, a transfer film from a wound body of the transfer film formed by applying at least a metal film onto a base film”, “which carries the transfer film withdrawn, starting at one end, by the film withdrawing mechanism to the downstream side”, “which transfers the metal film

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via an adhesive layer by heating while pressing the transfer film carried by the film carrying mechanism against a phosphor surface disposed on the face plate”, and “which winds while peeling the base film from the transfer film from which the metal film is transferred by the transfer mechanism” are found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus.

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

31. As to claim 3, Nakamura discloses a wrinkle-removing mechanism (11; See Figure 1).

32. The phrase, “which removes wrinkles which might be produced on the transfer film on the downstream side in the vicinity of the film withdrawing mechanism and in the vicinity of the disposed position of the transfer mechanism” is found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus

33. As to claim 7, Nakamura discloses a slide table (7) which is disposed at a position opposite to the transfer mechanism with respect to the transfer film being carried by the film carrying mechanism and slidable in parallel to a carrying direction of the transfer film, wherein the slide table moves and is therefore capable of a moving speed in a range of 0.5 m/min to 10 m/min (see Figure 1).

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34. The phrase, "while placing thereon the face plate on which the phosphor surface is formed" is found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus.

35. As to claim 8, Nakamura discloses a slide table (7) which is disposed at a position opposite to the transfer mechanism with respect to the transfer film being carried by the film carrying mechanism and slidable in parallel to a carrying direction of the transfer film, wherein the slide table moves and is therefore capable of a moving speed in a range of 0.5 m/min to 10 m/min (see Figure 1).

36. The phrase, "while placing thereon the face plate on which the phosphor surface is formed" is found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus.

### ***Claim Rejections - 35 USC § 103***

37. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

38. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,395,120 to Bradbury-Harris et al. as applied to claims 1-3 and 5-6 above, and further in view of U.S. Patent No. 6,004,420 to Nakamura et al.

39. With respect to claim 4, Bradbury-Harris does not specifically disclose a static elimination mechanism on the downstream side in the vicinity of the film withdrawing

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mechanism, on the side of the surface of the base film opposite to the adhesive agent coated surface of the transfer film on the downstream side of the adhesive agent coating mechanism, and in the vicinity of the disposed position of the transfer mechanism.

40. Nakamura et al. discloses a transfer apparatus, including a static elimination mechanism (12) on the downstream side in the vicinity of the film withdrawing mechanism, on the side of the surface of the base film opposite to the adhesive agent coated surface of the transfer film on the downstream side of the adhesive agent coating mechanism, and in the vicinity of the disposed position of the transfer mechanism (see Figure 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the static elimination mechanism taught by Nakamura with the transfer device of Bradbury-Harris. The motivation would have been to prevent contaminants and impurities from statically attaching to the film surface, and ultimately interfering with the laminate interface (column 4, lines 23-25).

41. The phrase, "which removes static electricity from the electrostatically charged transfer film" is found to be drawn to the intended use of the currently claimed apparatus, and do not further structurally define the apparatus.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number

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is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791